II. REMARKS/ARGUMENTS

These Remarks are in response to the Office Action mailed December 23, 2005. No fee is due for the addition of any new claims.

Claims 1, 4, 8, and 10-20 were pending in the Application prior to the outstanding Office Action. The Office Action rejected claims 1, 4, 8, and 10-20.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 4, 11-12 and 14-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stifelman, et al., "The Audio Notebook, Paper and Pen Interaction with Structured Speech," SIGCHI's 01, March 31-April 4, 2001, vol. 3, iss. 1, ACM 2001, pages 182-189 (hereafter, "Stifelman") in view of Arons el al., U.S. Pat No. 6,529,920 (hereafter, "Arons").

The Applicant herein supplies the declaration of Drs. Patrick Chiu, Donald G. Kimber, John Steven Boreczky and Andreas Girgensohn. In the declaration, Drs. Chiu, Kimber, Boreczky and Girgensohn state that they are employees of Fuji Xerox Palo Alto Laboratories, and specialize in computer software development. (Chiu et al. declaration, ¶2). Drs. Chiu, Kimber, Boreczky and Girgensohn, are co-inventors of U.S. patent application 09/843,197. (Chiu et al. declaration, ¶3). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "Lite Minutes system" prototype embodiment of the invention contained all the elements of Claim 1 as described and claimed in the above U.S. patent application (Chiu et al. declaration, ¶6). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "Lite Minutes system" prototype consists of "LiteMinutes.java" and "DataStore.exe" and software modules as listed in Exhibits A-C (Chiu et al. declaration, ¶7). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to receive a notation from a notetaker during a meeting as claimed in Claim 1, element (a) (Chiu et al. declaration, ¶8). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to automatically record an index value for the notation as claimed in Claim 1, element (b) (Chiu et al. declaration, ¶9). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to receive multimedia information from a multimedia source as claimed in Claim 1, element (c) (Chiu et

al. declaration, ¶10). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to automatically select a portion of multimedia information as claimed in Claim 1, element (d) (Chiu et al. declaration, ¶11). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to automatically create an association between a notation and selected multimedia information as claimed in Claim 1, element (e) (Chiu et al. declaration, ¶12). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes system" is able to store a notation and the association for retrieval at a future time as claimed in Claim 1, element (f) (Chiu et al. declaration, ¶13). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes.java" and "DataStore.exe" programs as shown in Exhibits A-C were compiled prior to March 31, 2001 (Chiu et al. declaration, ¶14). Drs. Chiu, Kimber, Boreczky and Girgensohn state that the "LiteMinutes.java" and "DataStore.exe" programs as shown in Exhibits A-C were completed versions of a prototype of the invention described and claimed in the above U.S. patent application (Chiu et al. declaration, ¶15). As such, these co-inventors are able to establish actual reduction to practice of this invention prior to the effective date of the *Stifelman* reference. Therefore, the *Stifelman* reference is not available to be combined with *Arons*. The Applicant respectfully requests that the Examiner reconsider this rejection.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stifelman in view of Arons and further in view of Davis et al., "Notepals: Lightweight Note Sharing by the Group, for the Group," ACM 1999, pages 338-345 (hereafter, "Davis").

As discussed above, the Applicant has shown that *Stifelman* is neither anticipatory nor prior art to the Applicants invention and as such is not available to be combined with *Arons* and *Davis*. The Applicant requests that the Examiner reconsider this rejection.

Claims 10 and 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stifelman in view of Arons and Davis and further in view of Mora et al. (U.S. Pat No. 6,161,113).

As discussed above, the Applicant has shown that *Stifelman* is neither anticipatory nor prior art to the Applicants invention and as such is not available to be combined with *Arons*, *Davis* and *Mora*. The Applicant requests that the Examiner reconsider this rejection.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 103(a) rejection.

III. CONCLUSION

The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all remaining claims, as amended in the subject patent application, should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of the patent.

No fee is believed due in connection with this paper. However, the Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Dated: 1/20/06

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